

## REMARKS

This responds to the Final Office Action mailed on July 24, 2008.

No amendments, cancellations, or additions are made to the claims. As a result, claims 34-36, 41, and 45-48 are now pending in this application.

For the convenience of the Examiner, Applicant's remarks concerning the claims will be presented in the same order in which the Examiner presented them in the Office Action.

### Rejection of Claims 34-36 and 47-48 under 35 U.S.C. §102(e) As being Anticipated by Patsiokas

Claims 34-36 and 47-48 were rejected under 35 U.S.C. §102(e) as being anticipated by Patsiokas (U.S. 6,493,546). Applicant does not admit that Patsiokas is prior art and reserves the right to swear behind Patsiokas as provided for under 37 C.F.R. §1.131.

The Examiner asserted in the most recent Office Action that Applicant's arguments fail to comply with 37 C.F.R. 1.111(b) and 1.111(c). Applicant assures the Examiner that Applicant will make every effort in this Response to satisfy 37 C.F.R. 1.111(b) and 1.111(c).

The Examiner asserts that Patsiokas discloses every element recited in independent claims 34-36 and 47-48.

Patsiokas discloses an apparatus and method for transmitting audio signals from an auxiliary source, such as a satellite broadcast receiver, a CD, or a cassette player to a radio receiver located, for example, in a vehicle, using a wireless link. See Abstract. The apparatus comprises a scanning receiver (58, FIG. 3) to locate open radio frequencies in the RF spectrum of the radio receiver. The open frequencies are conveyed to a microcontroller (60, FIG. 3), which displays them on a user display (36, FIG. 1). The apparatus modulates the source audio signals, using a user-selected radio frequency, and transmits them to the vehicle radio receiver, which is tuned to that frequency. It should be noted that Patsiokas fails to disclose any channel locator controller to identify an available non-interfering carrier frequency from an evaluation of two or more bands of FM carrier frequencies. Nor does Patsiokas disclose any out-of-band transmitter to transmit a channel selection signal comprising an available non-interfering carrier frequency.

The rule under 35 U.S.C. §102 is well settled that “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2D 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP §2131.

Patsiokas fails to disclose all of the structural elements recited in independent claim 34.

Patsiokas fails to disclose, for example:

*wherein the channel locator controller is configured to identify an available non-interfering carrier frequency from an evaluation of the two or more bands of FM carrier frequencies* [emphasis added]

The Examiner is reading Applicant’s channel locator controller on Patsiokas’ scanning receiver (58, FIG. 3)<sup>1</sup>. However, Patsiokas is totally devoid of any disclosure about the scanning receiver 58 identifying an available non-interfering carrier frequency from an evaluation of two or more bands of FM carrier frequencies.

Patsiokas also fails to disclose:

*an out-of-band transmitter to transmit a channel selection signal comprising the available non-interfering carrier frequency.* [emphasis added]

The Examiner is reading Applicant’s out-of-band transmitter on Patsiokas’ microcontroller (60, FIG. 3)<sup>2</sup>. The passages in Patsiokas cited by the Examiner totally fail to disclose any out-of-band transmitter, as recited in Applicant’s independent claim 34.

For example, the Examiner refers to Column 4, lines 61-67 of Patsiokas, which reads:

*When an RF channel is located which meets these criteria, the scanning receiver 58 provides the radio frequency to a microcontroller 60. The microcontroller 60 is programmed to display at least one, and preferably several, radio frequencies on the display 36 which represent possible low noise, open channels for the wireless link 15.*

<sup>1</sup> Office Action dated July 24, 2008, page 4.

<sup>2</sup> *Ibid.*, page 4.

The cited portion of Patsiokas is totally devoid of any disclosure about the microcontroller 60 having the ability to *transmit a channel selection signal comprising the available non-interfering carrier frequency.*

In Applicant's written description, an example of an out-of-band transmitter is described at page 7, lines 17-25:

*In another embodiment, to be discussed below, audio sink 112 can receive a channel selection signal from sound generation device 101, enabling it to automatically switch to the new transmission frequency of sound generation device 101. This can be carried out, for example, by transmitting a channel selection signal by an optional out-of-band transmitter 119. Out-of-band transmitter 119, which in one embodiment can transmit under the Bluetooth protocol, is coupled to channel selection circuit 107, and it transmits a channel selection signal, comprising the optimum available frequency, via antenna 109, through radio link 113, to antenna 114 of audio sink 112. [emphasis added]*

Clearly, by using the limitation "out-of-band transmitter", Applicant intended to limit this element to a transmitter transmitting over a radio link 113, i.e. a wireless transmitter. That is the plain and ordinary meaning of "out-of-band transmitter" to those of ordinary skill in this art.

Applicant is unable to find any corresponding disclosure in Patsiokas. Specifically, Patsiokas totally fails to disclose any out-of-band transmitter to transmit a channel selection signal comprising an available non-interfering carrier frequency.

Secondly, the Examiner also refers to Column 6, lines 7-13 of Patsiokas, which reads:

*The microcontroller 60 can indicate via the display 36 the random channel selection of the scanning receiver 58, the signal strength (i.e., RSSI) of satellite or terrestrially repeated SDARS signals, and visual effects (e.g. a dynamic bar graph display corresponding to the output levels of the audio program from the auxiliary audio source), among other displayable information.*

Again, the above-cited portion of Patsiokas is totally devoid of any disclosure about the microcontroller 60 having the ability to *transmit a channel selection signal comprising the available non-interfering carrier frequency.* The above-cited excerpt states that the microcontroller 60 can indicate a random channel selection via the display 36. By way of contrast, in an embodiment of Applicant's inventive subject matter, an out-of-band transmitter 119 (FIG. 2) can transmit a channel selection signal via a radio link 113 to the audio sink 112,

enabling it to automatically switch to a new transmission frequency being used by the sound generation device 101 (see page 7, lines 17-25, as quoted above).

Thus, Patsiokas fails to disclose all of the structural elements recited in independent claim 34.

**The Office's Rejection of the Claims is Capricious  
and Unreasonably Prolonged**

Applicant feels it is in a "twilight zone", as a result of the inconsistent and seemingly capricious treatment given to the claims and, in particular, to independent claim 34.

Table I below summarizes the tangled prosecution history of independent claim 34 from the time the claim was amended to recite the limitation "an out-of-band transmitter" to the most recent Final Office Action.

(In Table I, please note that the patent or publication number is given only for the first mention of the reference. Also, please note the distinction between two confusingly similar references, Parsiokas (2003/0060219), which was initially applied, and Patsiokas (6,493,546), which was later applied.)

From reading Table I, it is apparent that the Office has issued six (6) Office Actions rejecting Applicant's independent claim 34 since the time when this claim was amended to recite "an out-of-band transmitter".

Some of these Office Actions will now be discussed.

In the 7/1/05 Final Office Action, the Office totally failed to mention or consider the "out-of-band transmitter", so this was a wasted office action, so far as Applicant was concerned.

In the 3/31/06 Non-Final Office Action, the Examiner applied Patsiokas for the first time against claim 34, and the Examiner specifically stated that Patsiokas "does not disclose an out-of-band transmitter".

In the 8/3/06 Non-Final Office Action, the Examiner specifically stated that Applicant's arguments against the rejection of claim 34 had been fully considered and were persuasive. The Examiner specifically withdrew the previous 103 rejection (combining Patsiokas and Lehtonen).

In the 12/13/06 and 7/17/07 Office Actions, the Examiner apparently continued to hold that Lehtonen discloses an "out-of-band transmitter".

Next, totally unexpectedly, in the 2/21/08 Non-Final Office Action, the Examiner rejected claim 34 under Section 102 as anticipated by Patsiokas, despite the Examiner’s earlier holding in the 8/3/06 Office Action that Applicant’s arguments regarding claim 34 (including Applicant’s arguments that Patsiokas fails to disclose an out-of-band transmitter) were fully considered and were persuasive. Also, the Examiner again asserted that Patsiokas discloses an out-of-band transmitter, despite having held in the 3/31/06 Office Action that Patsiokas does not disclose any out-of-band transmitter.

| Date    | Paper                            | Activity  | Argument  |
|---------|----------------------------------|---|---|
| 3/30/05 | Amendment & Response Under 1.111 | Claim 34 was amended to include “an out-of-band transmitter to transmit a channel selection signal comprising an available carrier frequency” | Applicant argued against the previous 102 rejection of claim 34 as anticipated by Parsiokas (2003/0060219)                                    |
| 7/1/05  | Final Office Action              | Claim 34 was rejected under 103 as unpatentable over Parsiokas in view of Yee (6,085,090).  | The Examiner failed to mention or consider the “out-of-band transmitter” limitation added to claim 34.  |
| 1/3/06  | RCE #1; Response Under 1.116     | No claims were amended.   | Applicant argued Parsiokas fails to disclose any “out-of-band transmitter”.   |
| 3/31/06 | Non-Final Office Action          | Claim 34 was rejected under 103 as unpatentable over Patsiokas (6,493,546) in view of Lehtonen (2001/0049262).                                | <b><u>The Examiner stated that “Patsiokas does not disclose an out-of-band transmitter”</u></b> and asserted that Lehtonen does disclose one. |
| 5/31/06 | Response Under 1.111             | No claims were amended.   | Applicant argued that neither Patsiokas nor   |

|          |  |  |   |
|----------|--|--|---|
|          |  |  | Lehtonen discloses an out-of-band transmitter.  |
| 8/3/06   | Non-Final Office Action                  | Claim 34 was rejected under 103 as unpatentable over Noreen (5,455,823) in view of Lehtonen.   | <b><u>The Examiner stated that Applicant's arguments against the rejection of claim 34 have been fully considered and are persuasive. The Examiner specifically withdrew the previous rejection and applied a new rejection to claim 34, replacing Patsiokas with Noreen.</u></b> The Examiner continued to argue that Lehtonen discloses an out-of-band transmitter. |
| 10/3/06  | Response Under 1.111                     | No claims were amended.  | Applicant argued neither Noreen nor Lehtonen discloses an out-of-band transmitter.  |
| 12/13/06 | Final Office Action                      | The rejection of claim 34 under 103 as unpatentable over Noreen (5,455,823) in view of Lehtonen was maintained.  | The Examiner continued to argue that Lehtonen discloses an out-of-band transmitter.   |
| 5/1/07   | RCE #2; Amendment & Response Under 1.116 | Claim 34 was amended to recite "the FM carrier signal having a specific frequency within the range of 87.7 to 107.9 megahertz that does not interfere with | Applicant continued to argue that neither Noreen nor Lehtonen discloses all of the limitations of claim 34.   |

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|         |                                  | transmission frequencies in a commercial FM broadcast band of 87.7 to 107.9 megahertz in a geographical region in which the sound generation device is currently located”. Additional limitations were added to the “channel locator controller”. No amendment was made to the “out-of-band transmitter”. |   |
| 7/17/07 | Non-Final Office Action          | Claim 34 was rejected under 103 as unpatentable over Konisi (6,181,921) in view of Loomis (5,936,572) in further view of Lehtonen.  | The Examiner’s rejection was unclear and incomplete, but the Examiner apparently continued to argue that Lehtonen discloses an out-of-band transmitter.         |
| 9/14/07 | Amendment & Response Under 1.111 | Claim 34 was amended by adding further limitations to the “channel locator controller” and to the “out-of-band transmitter”.  | Applicant continued to assert that none of the 3 references discloses the limitations of claim 34.  |
| 2/21/08 | Non-Final Office Action          | <b><u>Claim 34 was rejected under 102 as anticipated by Patsiokas (6,493,546), despite the Examiner’s holding in the 8/3/06 Office Action that Applicant’s arguments regarding claim 34 (including that Patsiokas fails to</u></b>  | <b><u>The Examiner again argued that Patsiokas discloses an out-of-band transmitter, despite having held in the 3/31/06 Office Action that it does not.</u></b> |

|        |                                  | <b><u>disclose an out-of-band transmitter)</u><br/><u>were fully considered</u><br/><u>and were persuasive.</u></b> |   |
|--------|----------------------------------|---|---|
| 4/8/08 | Amendment & Response Under 1.111 | No amendments were made to claim 34.  | Applicant argued that Patsiokas fails to disclose any “out-of-band transmitter”.<br><br>Applicant also asserted the untenability of rejecting claim 34 as anticipated by Patsiokas under 102 after earlier withdrawing the rejection of claim 34 as unpatentable over Patsiokas and Lehtonen under 103. |

TABLE I

**Applicant Vigorously Asserts that the Office Should be Estopped from Asserting that Patsiokas Discloses an Out-Of-Band Transmitter**

The identical Examiner who drafted the current Office Action previously conceded in the March 31, 2006 Office Action that Patsiokas fails to disclose an out-of-band transmitter. She unequivocally stated that “Patsiokas does not disclose an out-of-band transmitter”.<sup>3</sup> Applicant completely agreed then, and Applicant continues to completely agree.

Because the Examiner stated in her March 31, 2006 Office Action that “Patsiokas does not disclose an out-of-band transmitter”, Applicant respectfully argues the Examiner should be estopped from once again --- nearly two years later --- attempting to read the out-of-band

<sup>3</sup> Office Action dated March 31, 2006, page 7.



transmitter of claim 34 on the identical Patsiokas reference. Applicant finds this highly unreasonable, illogical, unfair, and in fact outrageous.

Further, the identical Examiner previously stated in her August 3, 2006 Office Action that Applicant's arguments with respect to the rejection of independent claim 34 under 35 U.S.C. §103(a) as unpatentable over Patsiokas in view of Lehtonen were fully considered and were persuasive. So the Examiner withdrew that rejection. Because the Examiner earlier found Applicant's arguments against the Examiner's prior 35 U.S.C. 103(a) rejection persuasive, then the Office must concede that the Examiner's current 35 U.S.C. 102(e) rejection of claim 34 is even less tenable and that it should be withdrawn. Please note that claim 34, as pending at the time of the August 3, 2006 Office Action, had fewer limitations than the claim has for the current Office Action.

Applicant simply cannot comprehend the following:

- Claim 34 is narrower, i.e. it has more limitations, than at the time of the August 3, 2006 Office Action.
- The Examiner stated in the August 3, 2006 Office Action that Applicant's arguments against the rejection of claim 34 under 35 U.S.C. §103(a) as unpatentable over Patsiokas in view of Lehtonen were fully considered and were persuasive.
- The Examiner withdrew a Section 103 rejection of claim 34 over a combination of Patsiokas and another reference.
- Now, almost two years later, the Examiner is attempting to reject claim 34 under Section 102 over Patsiokas alone.
- There is no logic in the Examiner's actions. The Examiner previously held claim 34 was patentable over a combination of references that included Patsiokas. So the claim must be patentable over Patsiokas alone.

**Applicant Vigorously Asserts that the Office's  
Handling of the Rejection of Claim 34 is Capricious and Unreasonable**

Applicant strenuously objects to the Office's inconsistent handling of the rejection of claim 34. Applicant's claims, including claim 34, have already been subjected to nine (9) Office

Actions. Surely, the Office understands that Applicant cannot afford to prosecute this case indefinitely. Applicant respectfully asserts the Office has thrown and continues to throw an unreasonable and inconsistent barrage of rejections at claim 34. Applicant feels prejudiced and harmed by the Office's seemingly capricious and prolonged handling of this prosecution. It simply is unfair. Applicant's short-range and long-range product and business planning relative to this inventive subject matter cannot be conducted with any certainty, given the Office's failure to maintain a consistent or reasonable examination.

For the above reasons, independent claim 34 should be found to be allowable over Patsiokas, and Applicant respectfully requests that the rejection of claim 34 under 35 U.S.C. §102(e) as anticipated by Patsiokas be withdrawn.

Claims 35-36 and 47-48, which depend from claim 34 and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

**Rejection of Claims 41, 45, and 46 under 35 U.S.C. §103(a)**  
**as Unpatentable over Patsiokas in view of Konisi**

Claims 41, 45, and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Patsiokas in view of Konisi et al. (U.S. 6,181,921).

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA, 1974). MPEP §2143.

Neither Patsiokas nor Konisi disclose all of the limitations recited in independent claim 41. For example, neither Patsiokas nor Konisi disclose:

*an out-of-band transmitter to transmit a channel selection signal comprising the selected non-interfering carrier frequency.*

Patsiokas was discussed at length above. As previously mentioned, the Examiner earlier conceded that Patsiokas fails to disclose an out-of-band transmitter.

Konisi fails to disclose any out-of-band transmitter. Nor does the Examiner assert it does.

For the above reasons, independent claim 41 should be found to be allowable over any combination of Patsiokas and Konisi, and Applicant respectfully requests that the rejection of

claim 41 under 35 U.S.C. §103(a) as unpatentable over Patsiokas in view of Konisi be withdrawn.

If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. MPEP §2143.03.

Claims 45 and 46, which depend from independent claim 41, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Ann M. McCrackin (located in Minneapolis, Minnesota) at (612) 349-9592 or Applicant's below-signed attorney (located in Phoenix, Arizona) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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